

REMARKS

This amendment is submitted in response to the Notice of Non-Compliant Amendment mailed on April 27, 2005, which stated that April 21, 2005 Amendment was non-compliant. In particular, the Examiner stated that the claims were not provided with the proper status indicators. This Amendment includes the corrected status indicators, and is submitted as a replacement to the April 21, 2005 Amendment.

In the Office Action, claims 1-20 were rejected under 35 U.S.C. § 103(a). With this Amendment, claims 1 and 22-24 are canceled.

I. Applicant's Claims Are Not Obviousness In View of the Cited References

The examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. MPEP § 2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. MPEP § 2143.01. Second, there must be a reasonable expectation of success. MPEP § 2143.02. Third, to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCAP 1974); MPEP § 2143.03.

A. The Armstrong Patent in View of the Zebrowski Patent

In the Office Action, claims 17-21 were rejected under 35 U.S.C. § 103(a) as being obvious over Armstrong, U.S. Patent 4,927,046 ("the Armstrong patent") in view of Zebrowski, U.S. Patent 5,836,469 ("the Zebrowski patent"). In particular, the Examiner states that it would have been obvious to one of ordinary skill in the art to modify the pistol-grip holding vessel disclosed in the Armstrong patent to use a strap that is disclosed in the Zebrowski patent. However, the design of the holding vessel disclosed in the Armstrong patent would effectively prevent the use of a strap to urge and stabilize a hand against the outer surface of the holding vessel. Combining a strap feature disclosed in the Zebrowski patent would require removal of the ledge portion disclosed in the Armstrong patent, which, along with the pistol-grip

handle, are distinct features of the holding vessel. (the Armstrong patent, col. 4, ll. 23-26; and Figs. 1-6).

As such, despite the Examiner's suggestion, it would not have been obvious to one of ordinary skill in the art to modify the holding vessel disclosed in the Armstrong patent to use the strap feature disclosed in the Zebrowski patent. Accordingly, claim 17 is not obvious over the Armstrong patent in view of the Zebrowski patent. Similarly, claims 18-21, which depend from claim 17, are also not obvious over the Armstrong patent in view of the Zebrowski patent.

B. The Armstrong Patent in View of the Boom Patent

In the Office Action, claims 1-6, 8-14, and 16-21 were rejected under 35 U.S.C. § 103(a) as being obvious over the Armstrong patent in view of Boom, U.S. Patent No. 5,011,536 ("the Boom patent"). In particular, the Examiner states that it would have been obvious to one of ordinary skill in the art to modify the pistol-grip holding vessel disclosed in the Armstrong patent to use a strap that is disclosed in the Boom patent. However, as discussed above for the Zebrowski patent, the design of the holding vessel disclosed in the Armstrong patent would effectively prevent the use of a strap to urge and stabilize a hand against the outer surface of the holding vessel. Combining a strap feature disclosed in the Boom patent would also require removal of the ledge portion disclosed in the Armstrong patent, which, along with the pistol-grip handle, are distinct features of the holding vessel. (the Armstrong patent, col. 4, ll. 23-26; and Figs. 1-6).

As such, despite the Examiner's suggestion, it would not have been obvious to one of ordinary skill in the art to modify the holding vessel disclosed in the Armstrong patent to use the strap feature disclosed in the Boom patent. Accordingly, claim 2, 11, and 17 are not obvious over the Armstrong patent in view of the Boom patent. Similarly, claims 3-10, 12-16, and 18-21, which depend from claims 2, 11, and 17, are also not obvious over the Armstrong patent in view of the Boom patent.

C. The Armstrong Patent in View of the Boom Patent and the Vaughn Patent

In the Office Action, claims 7 and 15 were rejected under 35 U.S.C. § 103(a) as being obvious over the Armstrong patent in view of the Boom patent and Vaughn, U.S. Patent No. 3,536,285 (“the Vaughn patent”). However, as discussed above, claims 2 and 11 (which claims 7 and 15 respectively depend from) are not obvious over the Armstrong patent in view of the Boom patent. Moreover, the Vaughn patent only discloses a device for holding a paint brush in a paint container. As such, the Vaughn patent does not provide any additional disclosure, teaching, or suggestion to modify the holding vessel disclosed in the Armstrong patent to use the strap feature disclosed in the Boom patent. Accordingly, claim 2 and 11 (and correspondingly claims 7 and 15) are not obvious over the Armstrong patent in view of the Boom patent and the Vaughn patent.

D. The Armstrong Patent in View of the Boom Patent, the Vaughn Patent, and the Cox Patent

In the Office Action, claims 22-24 were rejected under 35 U.S.C. § 103(a) as being obvious over the Armstrong patent in view of the Boom patent, the Vaughn patent, and Cox, U.S. Design Patent No. D444,929 (“the Cox patent”). With this Amendment, claims 22-24 are canceled. As such, withdrawal of this rejection is respectfully requested.

II. Applicant’s Claims Are Not Obvious In View of Secondary Considerations

None of the claims are rendered obvious by the references made of record because there is extensive objective evidence of the present invention’s non-obviousness. The following enclosures were provided with the April 21, 2004 Amendment (copies are provided with the current Amendment).

- i. a Declaration of Mark W. Bergman, an inventor of the presently claimed invention (“Bergman Decl.”),
- ii. a Declaration of Alvin Preyer, a manufacturer’s representative of Bercom International, LLC (“Preyer Decl.”), and

iii. a product brochure from Bercom International, LLC (“Brochure”).

The following are additional enclosures provided with the current Amendment:

- i. a Declaration of David Gerber, a product manager with Hirshfields, Inc. (“Gerber Decl.”), and
- ii. a Declaration of Steve Holbrook, a purchasing manager with Rodda Paint Company, Inc. (“Holbrook Decl.”).

The present invention is assigned to Bercom International, LLC (“Bercom”). (Bergman Decl. at ¶ 3) As set forth in Mr. Bergman’s Declaration, Bercom has been selling containers under the trademark HANDY Paint Pail, which embody the inventions of the present application and Bergman, U.S. Patent No. 6,708,838 since early 2002. (Bergman Decl. at ¶ 6; Brochure) The attached Declarations, supporting Appendices, and brochure establish evidence of long felt need, skepticism by experts in the painting industry, and commercial success relating to the claimed containers. This evidence proves that the present invention is non-obvious.

A. Long Felt Need

The present invention came in response to a long felt need to reduce fatigue and hand cramping in the painting industry. (Bergman Decl. at ¶¶ 1, 5) The hand cramping during extended painting periods is what actually inspired Mr. Bergman to develop his idea for a container with the flexible strap. (Bergman Decl. at ¶ 1) The strap is flexible enough so that a person may insert his or her hand between the strap and the wall of the container. (Bergman Decl. at ¶ 1) The strap comfortably fits around the person's hand to urge the person's hand against the wall of the container. (Bergman Decl. at ¶ 1) This allows a person to hold the container for extended periods of time and reduces hand cramps, which typically occur when grasping paint containers for long periods. (Bergman Decl. at ¶ 1) Mr. Bergman has also received positive feedback from numerous consumers regarding the strap feature of the HANDY Paint Pail container and how it is easy to use and reduces hand fatigue. (Bergman Decl. at ¶ 5) Mr. Preyer also believes that the flexible strap is a key feature of the HANDY Paint Pail

container, which customers immediately take to upon learning how to properly use it. (Preyer Decl. at ¶¶ 3, 4)

As such, there was a long felt and unmet need in the painting industry for a container that provided the desired comfort and support to a person's hand during use. (P. 1, ll. 20-23 and P. 2, l. 25 to P. 3, l. 2) In 2002, Bercom met this long felt need by marketing and selling a container of the type that is disclosed and claimed in the present invention. (Bergman Decl. at ¶¶ 1, 4, 6)

B. Skepticism by Experts in the Painting Industry

As described in his Declaration, when Mr. Preyer, first saw the HANDy Paint Pail container, he was initially skeptical about its viability as a product. (Preyer Decl. at ¶ 5) With about 25 years of experience in the painting industry while working with Shur-Line and Meehan & Nolan Associates, Mr. Preyer is undoubtedly an expert in the painting industry. (Preyer Decl. at ¶¶ 1, 2) In fact, Mr. Preyer typically sees about 100 new product ideas for the painting industry each year. (Preyer Decl. at ¶ 1) However, despite his initial skepticism, Mr. Preyer believes that the HANDy Paint Pail container is a great product that has attained a substantial level of commercial success. (Preyer Decl. at ¶¶ 5, 7)

Mr. Gerber, and Mr. Holbrook were also initially skeptical about Mr. Bergman's idea. (Gerber Decl. at ¶ 3, Holbrook Decl. at ¶ 2) Mr. Gerber has over 30 years of experience dealing with products in the painting industry. (Gerber Decl. at ¶ 1) Similarly, Mr. Holbrook has about 23 years experience involved in identifying products that the retail stores of Rodda Paint Company may be interested in selling. (Holbrook Decl. at ¶ 1) When they first learned of Mr. Bergman's idea, each of them were initially skeptical that the HANDy Paint Pail container would succeed as a product. (Gerber Decl. at ¶ 3, Holbrook Decl. at ¶ 2) Nonetheless, they each agreed to sell the HANDy Paint Pail container in their respective retail stores, and were surprised by the rapid level of commercial success that the HANDy Paint Pail container achieved. (Gerber Decl. at ¶ 3, Holbrook Decl. at ¶ 2)

C. Commercial Success

The HANDy Paint Pail container was greeted with rapidly increasing commercial success upon its introduction. (Bergman Decl. at ¶ 1) Within the first ten months on the market, Bercom unexpectedly sold 170,000 HANDy Paint Pail containers through various retailers, with sales topping \$800,000. (Bergman Decl. at ¶ 6) This amount was more than 2½ times Bercom's initial expenditures for the HANDy Paint Pail containers. (Bergman Decl. at ¶ 6) In 2003, Bercom sold 380,000 HANDy Paint Pail containers, with sales of \$2.3 million (about 75% of the revenue was attributed to the sale of the HANDy Paint Pail containers, and the remaining 25% was attributed to plastic disposable liners used with the HANDy Paint Pail containers). (Bergman Decl. at ¶ 7) Following this trend of commercial success, in 2004, Bercom sold 700,000 HANDy Paint Pail containers. (Bergman Decl. at ¶ 7) As shown by these numbers, Mark Bergman is the classic example of an innovative person who invents a great idea and obtains outstanding commercial success due to his invention.

Due to the commercial success of the HANDy Paint Pail containers, Bercom has been authorized to sell the HANDy Paint Pail containers in a variety of well-established retailers, such as Ace Hardware stores, The Sherwin-Williams stores, True Value Hardware stores, Do-It-Best stores, and in over 1,700 The Home Depot stores. (Bergman Decl. at ¶ 10)

In addition to the unexpected level of sales, the HANDy Paint Pail container has also received numerous distinguished awards recognizing the uniqueness and revolutionary nature of the product from world-renowned organizations in the painting industry. (Bergman Decl. at ¶ 8; Preyer Decl. at ¶ 6) The following is a non-exhaustive list of awards that the HANDy Paint Pail container has received:

1. 2002 Consumer Products Silver winner in the Industrial Design Society of America's (IDSA) and Business Week Magazine's annual Industrial Design Excellence Awards (IDEA).
2. 2002 Member Tested and Recommended Seal from Handyman Club of America.
3. 2003 Member's Choice Award from Do-It-Best Corporation.

4. 2003-2004 Dealers' Pick for Outstanding New Item Award from the Hardware Conference.
5. 2004 "Product of the Year" from The Sherwin-Williams.
6. 2005 Creative Home Arts Member Tested Seal of Approval from Home Arts.

(Bergman Decl. at ¶ 8; Preyer Decl. at ¶ 6) These awards are further evidence of the remarkably quick and complete acceptance of the HANDy Paint Pail container by those in the painting industry, and the outstanding commercial success obtained by the HANDy Paint Pail container, which embodies the claimed invention of the present application.

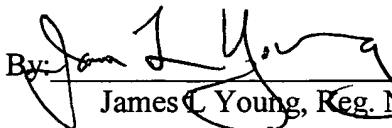
CONCLUSION

Pending claims 2-21 are not obvious in view of the references made of record. In addition, there is extensive evidence of non-obviousness of the present invention relating to long felt need and commercial success, and based on the attached evidence, pending claims 2-21 are in condition for allowance. Notification to that effect is respectfully requested.

Respectfully submitted,

KINNEY & LANGE, P.A.

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